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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,225	12/07/2005	Abdelhamid Sayari	OSLER1120	2908
28213	7590	03/03/2010	EXAMINER	
DLA PIPER LLP (US) 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			CORNO JR, JAMES A	
			ART UNIT	PAPER NUMBER
			1793	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,225

Applicant(s)

SAYARI, ABDELHAMID

Examiner

JAMES CORNO

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,13-16 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,13-16 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed November 12, 2009, have been fully considered but they are not persuasive.

Applicant contends that the specific surface area of mesoporous silica is beyond the useful range cited by Birbara. However, as noted in applicant's arguments, Birbara indicates an upper limit of "about 1000 m²/g" (emphasis added). The references cited by Stein as disclosing materials with "extremely high surface areas" have surface areas of approximately 1000 m²/g. See, for example, Beck et al. (*Journal of the American Chemical Society* **114**(27), p. 10834-10843, Dec. 1992) and Inagaki et al. (*Journal of the Chemical Society, Chemical Communications* **1993**(8), p. 680-682, Apr. 1993). The ranges are therefore not mutually exclusive.

Regarding the Sayari reference, it is not necessary for each reference to teach every limitation of the claim. Birbara teaches amine functionalization.

The rejection under 35 USC 102 has been overcome by the amendment requiring that the amines be covalently bonded to the silica. The rejection is therefore withdrawn.

All other rejections are maintained.

The new rejection below was based on the IDS submitted November 12, 2009, with fees as set for in 37 CFR 117(p). The rejection is therefore made final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Leal et al. (*Inorganica Chimica Acta* **240**, p. 183-189, 1993). Leal discloses an amine-functionalized mesoporous silica with covalently bound amines with an adsorption capacity of 10 cc/g at STP.

Regarding claim 2, the amines are bound to the entire surface.

Regarding claims 3 and 6, the surface is functionalized with 3-aminopropyltriethoxysilane (see section 2.1).

Regarding claim 7, since Leal's modification is the same as that of the instant specification (exposure of the silica to 3-aminopropyltriethoxysilane, it is assumed that the framework is similarly functionalized.

Regarding claim 8, the adsorbate is CO₂.

Regarding claim 9, the silica must be hydrophobic, since it is wettable by xylene.

Regarding claims 10 and 11, the amines are bound to the hydrophobic surface.

Regarding claim 13, the amines are grafted onto the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 8-11, 13-16, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbara et al. (US Patent No. 5,876,488) in view of Stein et al. (*Advanced Materials* **12**(19) p. 1403-1419, 2000). Birbara teaches a mesoporous material with an amine-functionalized surface for use as a reusable carbon dioxide adsorbent.

Birbara does not teach the use of mesoporous silica. Stein teaches that the surface of mesoporous silicas may be functionalized with amines through a known grafting process (section 2.1.2) and that functionalized mesoporous silica is useful as an adsorbent (section 4.2.4). It would have been obvious to one of ordinary skill in the art at the time of the invention to use any porous support fitting the requirements of Birbara (a porous material with high surface area that is readily functionalizable with useful amines; see col. 3, lines 25-47), including mesoporous silica, with a reasonable expectation of success.

Alternatively, Stein indicates that mesoporous silica is particularly useful for its readily tunable pore diameters (Introduction) and that pore diameter has been recognized as a factor in adsorption performance (section 4.2.4). It would have been obvious to one of ordinary skill in the art at the time of the invention to use mesoporous

silica in Birbara's adsorption device in order to allow fine-tuning of the pore diameter for maximum performance.

Neither Birbara nor Stein teaches the claimed CO₂ adsorption capacity. However, because the references teach the same structure (amine-functionalized, mesoporous silica) made by the same process (grafting or co-condensation), the CO₂ adsorption capacity is assumed to be the same.

Regarding claim 2, Stein teaches that amines may be covalently bound to the surface of the silica (section 2.1.2).

Regarding claim 3, Stein teaches that trialkoxysilanes may be used for grafting (section 2.1.3).

Regarding claim 8, Birbara teaches carbon dioxide adsorption.

Regarding claim 9, Birbara teaches a method of dry-scrubbing in which the amine-functionalized support is exposed to a gaseous stream containing an acid gas.

Regarding claim 10, Stein teaches that amines may be covalently bound to the surface of the silica (section 2.1.2).

Regarding claim 11, Stein teaches that areas not covered by grafting may be hydrophobic or may be made hydrophobic (section 2.1.3).

Regarding claim 13, Stein teaches that grafting may be accomplished by exposing the silica to silanes containing the desired functional groups.

Regarding claim 14, Stein teaches that the functionalized silica may be formed by co-condensation (section 2.3).

Regarding claims 15 and 16, Stein teaches that grafting may be accomplished by reacting surface groups with amines (section 2.1.2).

Regarding claim 20, Stein teaches that the surface may be functionalized by first adding alkyl halides to the surface and then displacing the halogen with the desired functional group.

Regarding claim 21, Birbara teaches that amine-terminated porous structures may be used in a dual bed system including pumps and valves (Fig. 1).

Regarding claim 22, Birbara teaches CO₂ removal.

Regarding claims 23-24, Birbara teaches that the sorbent may be in pellet form (col. 3, line 55). It would have been obvious to one of ordinary skill in the art at the time of the invention to use any appropriate binder, whether reactive or inert, with a reasonable expectation of success.

Claims 7, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbara in view of Stein as applied to claims 1 and 9 above, and further in view of Sayari. Birbara in view of Stein does not teach functionalization of an organosilica framework. Sayari teaches that organosilica provides superior structure control to that of the other mesoporous silicas. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Sayari's mesoporous organosilica as the support for Birbara's adsorbent in order to maximize structure control.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on November 12, 2009, prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES CORNO whose telephone number is (571)270-5829. The examiner can normally be reached on Monday-Thursday 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melvin Curtis Mayes can be reached on 571-272-1234. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES CORNO/
Examiner, Art Unit 1793

February 25, 2010

/Melvin Curtis Mayes/
Supervisory Patent Examiner, Art Unit 1793